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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,281	05/15/2001	Takenori Kohda	JP920000095	1913
7590 10/05/2004			EXAMINER	
Robert P. Tassinari, Jr. Intellectual Property Law Dept. IBM Corporation P.O. Box 218 Yorktown Heights, NY 10598			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 10/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,281

Applicant(s)

KOHDA ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 1-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/855,281.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-22 are pending.

Specification

2. The title of the invention is not clear. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Method for guiding a user to a desired network site."

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

4. Claims 1-6 are objected to for use of the term "user guidance method." This expression is not specific enough to indicate the use of a computer or processor.
5. Claims 7 and 8 are objected to for use of the term "content advertisement method." This expression is not specific enough to indicate the use of a computer or processor.
6. Claims 9-11 are objected to for use of the term "user guidance system." This expression is not specific enough to indicate the use of a computer or processor.

Art Unit: 2155

7. Claims 12-19 are objected to for use of the term "object control system." This expression is not specific enough to indicate the use of a computer or processor.
8. Claim 12 is objected to because of the following informalities: Applicant writes "...or delete from a specific web page..." It is believed Applicant meant to write "...or to be deleted from a specific web page..." Appropriate correction is required.
9. Claim 17 is objected to because of the following informalities: Applicant writes "...and changes said location of said object web pages are browsed by said user." It is believed Applicant meant to write "...and changes said location of said object when web pages are browsed by said user." Appropriate correction is required.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-6 and 9-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 9 recite a user guidance method, which does not explicitly state that computer hardware is involved.

Art Unit: 2155

Claims 12, 16, and 19 recite an object control system, which is essentially software per se. Applicant does not explicitly state that computer hardware is part of the system.

As to claim 20, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

As to Claim 21, it recites "...said program permitting said computer to perform..." which is not substantially equivalent to the program being executed by a computer.

As to claim 22, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Additionally, the use of the word "transmission" in the context of the application is unclear.

See also MPEP 2106.IV.A & B.



Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

Art Unit: 2155

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-9, 11, 18, 19, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Miles et al. (U.S. 6,102,406).

14. As to claim 1, Miles teaches a user guidance method comprising the steps of: permitting an object, that can be obtained by a user, to appear at a specific location of a specific site (Miles, col. 10, lines 45-49), moving the object (Miles, col. 10, line 64-col. 11, line 1), and a user who wishes to obtain the object is guided to predetermined content available at the site (Miles, col. 3, lines 35-38). A hypertext link is an object and therefore having the link appear at a different page after a previous page is accessed is inherently moving it.

15. As to claim 2, Miles discloses the invention substantially as described in claim 1, including waiting until object is obtained by users (Miles, col. 10, lines 45-49) and permitting the object, after it has been obtained by any of the users, to appear at a different location at a specific site (Miles, col. 10, line 64-col. 11, line 1).

16. As to claim 3, Miles discloses the invention substantially as described in claim 1, including providing information concerning the location of the object to the user (Miles, col. 10, lines 5-8).

Art Unit: 2155

17. As to claim 4, Miles discloses the invention substantially as described in claim 1, including moving the object along a predetermined route and consequently the user is guided through predetermined content in accordance with a specific order (Miles, col. 4, lines 48-57).
18. As to claim 5, Miles discloses the invention substantially as described in claim 1, including permitting the object to appear at specific locations at multiple sites across a network and moving the object across this network (Miles, col. 3, lines 26-31).
19. As to claim 6, Miles discloses the invention substantially as described in claim 5, including moving an object along a predetermined route across multiple sites on a network and consequently the user is guided through predetermined content in accordance with a specific order (Miles, col. 10, line 64-col. 11, line 2). In order for the participant to be presented with the next clue, he must submit the correct answer to the current question, so a predetermined order is inherent.
20. As to claim 7, Miles discloses a content advertising method (Miles, col. 1, lines 6-7) comprising: permitting an object, that can be obtained by a user, to appear on a network that multiple users can browse and moving the object when a predetermined user browses its contents to contents multiple users can browse (Miles, col. 12, line 66-col. 13, line 5), and where the user who desires to obtain the object is guided to browse network contents (Miles, col. 10, lines 24-27).

Art Unit: 2155

21. As to claim 8, Miles discloses the invention substantially as described in claim 7, including at the step of moving the object through contents multiple users wish to browse (Miles, col. 12, line 66-col. 13, line 5).
22. As to claim 9, Miles discloses a user guidance system comprising: an object manager for managing the location of an object on a network (Miles, col. 13, lines 36-46), a position information generator for generating information concerning the location of the object and for providing information to a user (Miles, col. 10, lines 5-8), a processor for performing a predetermined process when the object is selected by a predetermined user (Miles, col. 11, lines 1-5), and the object manager arranges the object at a desired location in order to guide the user to the desired contents on the network (Miles, col. 10, lines 14-49).
23. As to claim 11, Miles discloses the invention substantially as described in claim 9, including a processor transmitting a notification that the object has been selected by a predetermined user to the object manager that managers information about a specific user (Miles, Fig. 5, element 32), and all others who select the object are not regarded as having selected the object (Miles, col. 12, lines 30-35).
24. As to claim 18, Miles discloses an object control system comprising: an object stored in a predetermined server (Miles, Fig. 5, element 36), a link setting means for setting a link in a web page stored at a web site on the network in order to move the object (Miles, col. 10, lines 45-49), object position management means for determining a

page for setting a link (Miles, col. 13, lines 38-46) where the object position management means controls the link setting means to change a target web page for setting a link (Miles, Fig. 5, element 36).

25. As to claim 19, Miles discloses the invention substantially, as described in claim 18, including the object position manager defining a target web page to which the link to is to be set and changing the target web page when the predetermined user browses the web pages (Miles, col. 10, lines 45-49; col. 10, line 64-col. 11, line 1).

26. As to claim 21, Miles discloses a storage medium on which input means of a computer stores a program in an input-enabled form (Miles, col. 5, lines 42-49) where the program permits a computer to perform: a process for permitting a specific object to appear on a specific web page stored on a specific server (Miles, col. 10, lines 45-49), and a process for moving an object to another page when a user browses the specific web site and selects the object (Miles, col. 10, line 64-col. 1, line 1).

27. As to claim 22, Miles discloses a program transmission apparatus comprising: a storage means for storing a program permitting a computer to perform (Miles, col. 5, lines 42-49), a process for permitting a specific object to appear on a web page stored on the web server (Miles, col. 10, lines 45-49), and a process for moving an object to another page when a user browses the specific web site and selects the object (Miles, col. 10, line 64-col. 1, line 1), and transmission means for reading the program from the storage means and for transmitting the program (Miles, col. 5, lines 42-49).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 10, 12-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles and further in view of Underwood (U.S. 6,523,027).

30. As to claim 10, Miles discloses the invention substantially, as described in claim 9, including a processor transmitting a notification that the object has been selected (Miles, col. 11, lines 1-5), but does not teach the deleting and positioning of another object. However, Underwood teaches the deletion and creation of another object by the object manager (Underwood, col. 55, lines 43-45). It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the database with the main server (Underwood, col. 10, lines 32-36).

31. As to claim 12, Miles discloses an object control system comprising: of web servers (Miles, Fig. 3, element 26), a main server for communicating with a predetermined web server (Miles, Fig. 3, element 20), but does not teach a main server adding or deleting an object from a web page. However, Underwood teaches the main server permitting an object to appear or being deleted (Underwood, col. 55, lines 43-45)

Art Unit: 2155

from a web page stored in the web server (col. 2, lines 18-19; Fig. 33). It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the database with the main server (Underwood, col. 10, lines 32-36).

32. As to claim 13, Miles discloses the main server detecting that user has selected the object (Miles, col. 11, lines 1-5), but does not teach deleting and moving an object to another page. However, Underwood teaches deleting and adding an object (Underwood, col. 55, lines 43-45) to another web page (Underwood, col. 2, lines 18-19). It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the third party advertiser sites with the main server (Underwood, col. 10, lines 32-36).

33. As to claim 14, Miles-Underwood discloses the invention substantially, as described in claim 12, including the main server providing information concerning the location of the object to the user (Miles, col. 10, lines 5-8).

34. As to claim 15, Miles-Underwood discloses the invention substantially, as described in claim 14, including providing information concerning the ease of locating the object from the web page browsed by the user (Miles, col. 15, lines 59-61).

35. As to claim 16, Miles discloses an object control system comprising: an object managing means for managing the location of the object on the network and where the object management means changes the location of the object on the network to

Art Unit: 2155

move it across the network (Miles, col. 13, lines 36-46), but does not teach an embedded object on a web page. However, Underwood does teach an object to be embedded in a web page stored at a web page on a network (Underwood, col. 130, lines 59-62). An embedded object is usually one that is created using a program that is outside the one in which the object currently resides. It would have been obvious to combine the teachings of Miles and Underwood to include the use of objects created outside of a web page file, such as embedded pictures (Underwood, col. 321, lines 18-19).

36. As to claim 17, Miles-Underwood discloses the invention substantially, as described in claim 16, including the object management means correlating the location of the object with a web page browsed by a predetermined user and changes the location of the object when the web pages are browsed by the user (Miles, col. 10, line 64-col. 11, line 1).

37. As to claim 20, Miles discloses an object stored at a web site on a network and the object's location on the network is managed by management means which move it from one predetermined web page to another (Miles, col. 14, lines 31-34 and 63-66), but does not teach an object embedded in a web page. However, Underwood teaches an object which is embedded in a web page (Underwood, col. 130, lines 59-62). An embedded object is usually one that is created using a program that is outside the one in which the object currently resides. It would have been obvious to combine the

Art Unit: 2155

teachings of Miles and Underwood to include the use of objects created outside of a web page file, such as embedded pictures (Underwood, col. 321, lines 18-19).

Art Unit: 2155


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (703) 305-8865. The examiner can normally be reached on 7:15am - 3:45pm, Monday - Friday. The examiner will be moving in mid-October and can be reached then at (571) 272-3981. The Tech Center main telephone number will be (571) 272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB


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